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No. 3945.

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IN THE  
United States  
Circuit Court of Appeals,  
FOR THE NINTH CIRCUIT.

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David G. Lorraine,

*Appellant,*

*vs.*

Francis M. Townsend, Milon J. Trumble and Alfred J. Gutzler Doing Business Under the Firm Name of Trumble Gas Trap Company,

*Appellees.*

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PETITION FOR REHEARING.

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FREDERICK S. LYON,  
LEONARD S. LYON,  
FRANK L. A. GRAHAM,  
*Solicitors for Plaintiffs-Appellees.*



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PETITION FOR REHEARING.

*To the Honorable Judges of the United States Circuit Court of Appeals for the Ninth Circuit:*

The plaintiff-appellees, FRANCIS M. TOWNSEND, MILON J. TRUMBLE and ALFRED J. GUTZLER, doing business as the TRUMBLE GAS TRAP COMPANY, believing themselves aggrieved by this court's decision filed June 4, 1923, come now and respectfully petition this court for a rehearing upon the following grounds:

Italics appearing hereinafter may be deemed ours.

### **Both Parties Concur in Asking Rehearing.**

We have been served with copy of petition of defendant-appellant for rehearing of this case. It is evident that the decision of this court is not considered an equitable one by either party, that a rehearing should be granted, and that the decision should be restated.

### **The Trumble Patent Is Admittedly Valid.**

In considering this case, since the court did not declare any claim to be invalid, the court evidently did not lose sight of the fact that claims 1, 2, 3 and 4 of the Trumble patent sued on in the court below are shown by the record to have been repeatedly stipulated and admitted by the defendant to be valid, in the court below, and that the only question before the court is the interpretation or scope to be given the claims.

We think the court has been led to take an erroneous position as to certain points of fact and law as follows:

**First: The Court Was Misled as to the Proceedings in the Patent Office, in Regard to the Trumble Patent, and as to the Law Relating Thereto Reversed Its Own Settled and Established Practice.**

This is a most important point and one upon which the whole decision rests.

It cannot be said that any of the claims of the Trumble patent are ambiguous or uncertain but on the contrary, although fairly broad, they are most definite.

This point can be settled by a mere reading of the claims and needs no argument from us. Claim 4, which we will hereinafter use as an example to save extended discussion, reads as follows:

“4. In an oil and gas separator, the combination of an expansion chamber, means for delivering oil and gas into the chamber, **means for maintaining pressure** within the chamber, means for drawing oil from the chamber, and means within the chamber adapted to cause the oil to flow in a thin body for a distance to enable the gas contained and carried thereby to be given off while the oil is subjected to pressure.

Can it be said that this claim is *ambiguous* or *uncertain*? It seems to us most definite and certain.

It is well settled that a patentee who acquiesces in the rejection of claims by the Patent Office is thereby estopped from later asserting that the allowed claims should be construed as equivalent to the rejected ones. See *Cole v. Ed. G. Hookstratten Cigar Co.*, 250 Fed. Rep. 629; *W. F. Schultheiss Co. v. Phillips*, 264 Fed. Rep. 971; *Selectasine Patents Co. v. Prest-O-Graph Co.*, 282 Fed. Rep. 223. In all these cases *this* court definitely relied on and restated this doctrine.

*But this doctrine has no application to the file wrapper of the patent in suit.* Claim 4, for example, was inserted by amendment of March 15, 1915, p. 31, Exhibits. It did not supersede broader claims which were cancelled but was in itself broader than original claim 7, p. 24, Exhibits, the only original claim which con-

tained pressure regulating means in the gas outlet and which was later allowed and appears in the patent as claim 8.

At the same time that claim 4 was inserted the specification was amended, p. 31, Exhibits, to further bring out the novel feature of the Trumble invention already well stated in the specification, i. e., the pressure regulating means or **means for maintaining pressure** which was used to force the dry gas out of the oil and hold the gasoline in. This shows that Trumble appreciated and at that time claimed broadly the substance of claim 4. The Patent Office *never* rejected any claim on the grounds that **pressure maintaining means** was old in the art.

This amendment was *admitted* by the Patent Office *and the claims were allowed*. Claim 4, so far as *structure* is concerned was much broader than any claims previously in the case. There was no acquiescence in the rejection of any claim containing a **pressure regulating means** and no estoppel.

The solicitor for Trumble was, however, met by a rejection as to structure claimed in *claim 1* on the patent to Bray and he met this rejection with an argument as to the structural differences, and not as to the fundamental feature of pressure since the examiner had not contended and could not contend that **means for maintaining pressure** were old in the art. In other words the solicitor met the examiner's rejection with an argument on that rejection and naturally did not go outside that rejection to argue points that were not in issue. With all the evidence

in this case before us we can *now* see that the argument of the solicitor did not state *all* the grounds upon which Trumble might have relied. It met the rejection, however, and *it was successful*. The court, in considering the Trumble file wrapper, evidently thought that since Trumble's solicitor did not state *all* the available arguments to overcome the Bray patent before the Patent Office, we are thereby precluded from presenting to this court other arguments which are amply supported by the evidence.

In the absence of any estoppel of the patentee by acquiescence it would seem to us that this court should proceed to do justice on the *facts*, unhampered by any limitations due to the solicitor's mere argument or to the failure of the solicitor to fully present to the Patent Office *all* the arguments in the applicant's favor. If Trumble's solicitor had presented to the Patent Office the facts urged here and had *lost*, before the Patent Office, we might have been estopped. What he did, however, was to present a *much weaker* argument before the Patent Office upon which he *won*. Certainly this does not preclude our using the stronger argument here, since it is clearly supported by the evidence.

The Supreme Court has well enunciated the true doctrine as follows:

"While not allowed to revive a rejected claim, by a broad construction of the claim allowed, yet the patentee is entitled to a *fair construction* of the terms of his claim as actually granted."

Huppel v. United States, 179 U. S. 77, 45 L. Ed. 95.



So also other Circuit Courts of Appeal have spoken definitely on this point as follows:

“It is of the essence of the rule \* \* \* that \* \* \* the estoppel does not extend to a matter not stated in the objection or disclosed by the reference.”

Vrooman v. Penhallow, 179 Fed. Rep. 297.

“The rule on this topic \* \* \* is to the effect that, in order that the proceedings in the Patent Office should operate as a waiver or estoppel, they must relate to the pith and marrow of the alleged improvement, and be understandingly and deliberately assented to. This rule has been many times approved by the federal courts.”

United States Peg Wood, S. & L. B. Co. v. B. F. Sturtevant Co., 125 Fed. Rep. 384.

See also:

National Hollow Brake Beam Co. v. Interchangeable Hollow Brake Beam Co., 106 Fed. Rep. 714;

Stead Lens Co. v. Kryptok Co., 214 Fed. Rep. 375;

New York Scaffolding Co. v. Whitney, 224 Fed. Rep. 462;

J. L. Owens Co. v. Twin City Separator Co., 168 Fed. Rep. 259.

It is not necessary, however, to go to either the Supreme Court or to other Circuit Courts of Appeal for a complete exposition of the law on this point. This court itself has handed down decisions in which the rule is clearly and definitely enunciated. In one



case decided in 1908, this court in a very thorough and sweeping analysis of the law, after carefully reviewing various authorities, said:

“In the light of these authorities, it is clear that the claims of the patent, unambiguous as they are, are to be interpreted according to the meaning of their own terms, and are not to be controlled or limited by any argument or representation made in the Patent Office by the applicant’s attorney as to the scope of the invention or the features wherein it differs from the prior art.”

Fullerton Walnut Growers Association v. Anderson-Barngrover Mfg. Co., 166 Fed. Rep. 452.

So, also *this* court in another decision said:

“But it has been held, in effect, by this court that, where the claims allowed are not uncertain or ambiguous, the courts should be slow to permit their construction of the patent actually granted and delivered to be affected or controlled by alleged interlocutions between the Patent Office and the claimant.”

Selectasine Patents Co. v. Prest-O-Graph Co., 267 Fed. Rep. 845.

Citing:

Fullerton W. G. Assn. v. Anderson Barngrover Mfg. Co., 166 Fed. Rep. 443;

Westinghouse v. Boyden Power Brake Co., 170 U. S. 582.

We respectfully submit that the court’s decision in this case is almost wholly based on the assumption that Trumble limited his claims by the proceedings

in the Patent Office. This is an erroneous assumption as to the facts as is evident from a short study of the Trumble file wrapper. The paragraph beginning at the top of page 9 of the decision and upon which the whole decision rests is not only based upon an erroneous assumption of facts but also is an absolute reversal of the law as established by the Supreme Court case, the three cases in other circuits and the two cases of *this* court above cited.

It cannot be said that claim 4 is ambiguous or uncertain or that it is susceptible of various interpretations. It is definite and certain, admitted by the defendant-appellant to be valid, and most certainly infringed by defendant-appellant's devices.

**Second: The Court Was Misled Into Holding That There Was No Claim Made, That the Physical Law Involved in the Patent in Suit Was New but That This Law Was Well Known, the Court Citing Standard Oil Co. v. Oklahoma, 284 Fed. 469-472.**

This is a serious error as to the facts.

The Saybolt patent referred to in this cited decision did not relate to a gas trap or a device for *taking gas out of oil*, but to a device for an exactly opposite purpose, that is, a device for causing a portion of the *gas to be absorbed by oil*. Saybolt used pressure, not to facilitate the *escape* of gas from oil, but for the purpose of forcing a portion of the natural gas to be *absorbed* by an oil. Saybolt was seeking *absorption*; Trumble was seeking *release*. The teaching of the Saybolt patent would in fact lead one to believe that

the Trumble gas trap would be inoperative, as Saybolt used pressure for an entirely different purpose and obtained an exactly opposite result to Trumble. Moreover, since counsel for defendant cited the Standard Oil v. Oklahoma decision he also knew of the Saybolt patent, but he wisely did not put it in evidence. It is, therefore, to be assumed, as is a fact, that the Saybolt patent is not pertinent to the issues herein. The court was undoubtedly misled by counsel's argument on this most essential point, and this error has led to serious inconsistencies and further error, as will be later pointed out. Trumble *did* discover and apply a new principle in the art, namely, that pressure **maintained** on a gas trap would facilitate the escape of the dry gas therefrom. This was a novel and unexpected result not foreshadowed in any way in the prior art. It was not based on the principle of absorption used in the Saybolt patent, but on the principle of *partial pressures* which was unknown at the time Trumble made his invention, as clearly shown by the evidence. [See Record, p. 80.]

Trumble's object was to save gasoline, the saving of gas being of minor importance, and no prior patent was directed to this object, all of the prior patents being directed to saving the gas and incidentally wasting the gasoline.

**Third: The Court Was Also Misled as to the Facts and Assumed That the Combinations Claimed by Trumble Were Old in the Art.**

For convenience in discussion, we can consider claim 4 which contains (in addition to certain old elements) two significant elements *in combination*, that is

(a) **Means for maintaining pressure** within the chamber;

(b) Means within the chamber adapted to cause the oil to flow in a thin body for a distance to enable the gas contained and carried thereby to be given off while the oil is subjected to pressure.

Note that means (a) is a **means for maintaining pressure** and is not met by showing that due to exterior causes pressure *might* at times be partially or temporarily caused in a trap.

Of the prior gas traps found in the art, *not a single trap shows the combination of elements (a) and (b)*, and further in no case is any trap in the prior art provided with any structure suited to *maintain* pressure.

The Trumble patent is not a process patent but an apparatus patent claiming a *combination* of specific mechanical elements. One of these elements, namely, the **pressure maintaining means (b)** *is not found in the art*. The court has *assumed* that it is present in certain prior patents but the patents themselves are silent on this point.

By dividing his oil into a thin body and *maintaining* a pressure on it, Trumble accomplished certain very wonderful results, as stated in his patent specification and as clearly shown by the evidence.

The Cooper patent No. 815,407, p. 133, Exhibits, does not show or describe any “**means for maintaining pressure.**” It is true Cooper says that “*in a contemporaneous application*” he shows means, namely, a compressor, for forcing gas from a gas trap *into a*

well, but this is the application of pressure to gas going down into a well and not to the gas trap. Whatever Cooper may have shown in a *contemporaneous application* is not evidence here and since the defendant did not put this contemporaneous application in evidence, we are justified in assuming it is not of any importance in this case.

It is also true that Cooper says that high pressure *may* be maintained in the cylinder, but he does not say that it *is* maintained and neither shows nor described any **means for maintaining this pressure**. His gas outlet line F is free from even a valve. If it had an ordinary manually operated valve it would still not have **means for maintaining pressure**, this means in the Trumble patent being the automatic "gas pressure regulating valve" 11. The valve 11 of Trumble *automatically maintains* pressure under all conditions of gas and oil flow of the well. If the flow increases, it opens. If the flow diminishes, the valve 11 closes to the necessary degree to maintain a predetermined pressure. It is a **means for maintaining pressure**. The defendant has a valve exactly like it in the valve 28 of his patent, p. 66, Exhibits. No such valve or anything approaching it is either shown or described in the prior art.

The court apparently entirely lost sight of the fact that the Trumble patent is a *combination* apparatus patent and that elements entirely absent from the prior art cannot be imported or read into combinations, from which they are absent, for the purpose of anticipation.



McIntosh also has no means for maintaining pressure. His gas pipe 9 is entirely free from valves. There is not one word in his patent which indicates that he intended **to maintain pressure** therein. Even accepting the court's assumption that pressure *might* be present, we are still far short of finding any **means for maintaining pressure**. In other words, we do not find Trumble's claimed combination of elements.

Bray is far from showing **pressure maintaining means**. In fact he shows an overflow pipe 20 equipped with a *vacuum breaker* 30. His gas outlet pipe 17 is free from valves and the trap is vented through the pipe 28 to the open air.

None of the prior patents except Cooper *speak* of pressure and he is *vague* and *indefinite*. Certainly none of them show or describe actual *means* for accomplishing Trumble's new and useful result, i. e., the combination of the elements (a) and (b).

**Fourth: The Court Having Been Led by Counsel to Assume Certain Elements to Be Found in the Prior Art in the Combination Claimed by Trumble, Resolved All Doubts in Relation Thereto Against the Plain Words of the Patent and the Evidence. This Is an Error of Law and Is Contrary to the Well Established Principles of This Court.**

This court has, in the past, always construed patents fairly and in accordance with their plain words. For example, see:

Letson *et al.*, v. Alaska Packers' Ass'n, 130 Fed. Rep. 129;

Beryle v. San Francisco Cornice Co. v. Hickmott Asparagus Canning Co., 137 Fed. Rep. 86, and

Los Angeles Art Organ Co. v. Aeolian Co. *et al.*, 143 Fed. Rep. 880.

These are all Ninth Circuit cases in which this court has refused to construe patents otherwise than in accordance with their *obvious and plain language*.

In this case the court has made certain assumptions. First, it has assumed that Trumble limited his patent by the proceedings in the Patent Office. Second, it has assumed that the principle of the Trumble gas trap was old. Third, it has assumed that **means for maintaining pressure** on such a trap was old in the art. None of these assumptions are supported by the evidence, but are based wholly upon inference. The court has then, basing its findings on these assumptions, placed the narrowest structural construction on claims which specify in the broadest terms "*means*" for accomplishing a result.

In so doing the court has, in effect, reversed its previous fair, liberal and constructive policy.

The Fifth Circuit in a case published June 21, 1923, says:

"Where anticipation is relied on as a defense it should be clearly proved, and, in cases of reasonable doubt, the doubt should be resolved in favor of the patent attacked."

Atlantic, Gulf, & Pacific Co. v. Wood, 288 Fed. Rep. 154.



Citing:

Coffin v. Ogden. 18 Wall 120, 21 L. Ed. 821;  
Victor Talking Machine Co. v. Duplex Phonograph Co., 177 Fed. 248;  
Simonds Rolling Machine Co. v. Hathorn Mfg. Co., 93 Fed. 958.

**Fifth: The Court Was Misled Into Ignoring the Great Weight of the Evidence as to Utility in the Trumble Invention.**

This was a wide departure from the settled practice of this court, and one which sets a dangerous and insidious precedent.

The evidence shows that the Trumble gas trap made enormous savings in the oil industry due to the combination of the dividing means (a) and the pressure maintaining means (b). For example, one trap alone saved \$125.00 per day and Trumble sold 583 traps. There was no claim made or evidence introduced to show that any trap in the prior art could have made this saving, and in fact no prior trap could have made it. Trumble has conserved enormous quantities of gasoline and oil. His patent is not a mere paper patent. It is an invention that made enormous savings and is now making enormous savings for the oil industry.

The court has evidently not considered this but has given the patent an interpretation which limits it to definite structure and which absolutely ignores the true nature of the Trumble invention and the great public benefit that has accrued therefrom.

In so doing, the court has again widely departed from its previous well settled policy.

The court is referred to the following cases:

H. J. Heize Co. v. Cohn, 207 Fed. Rep. 547;

Morton v. Llewellyn *et al.*, 164 Fed. Rep. 693;

Stebler v. Riverside Heights Orange Growers Ass'n *et al.*, 205 Fed. Rep. 735;

Hyde v. Minerals Separation, Limited *et al.*, 214 Fed. Rep. 100;

Sherman Clay Co. v. Searchlight Horn Co., 214 Fed. Rep. 86;

Majestic Development Co. v. Westinghouse Elec. & Mfg. Co., 276 Fed. Rep. 676.

These are Ninth Circuit cases in which this court has given weight to the proven utility and important commercial results flowing from the invention before it.

The court should also not lose sight of the fact that long before the defendant-appellant appropriated the Trumble combination, that Trumble had made and sold hundreds of his gas traps and therefore occupied a dominating position in the commercial field.

**Sixth: The Court Has Been Misled to Such a Degree That It Has Issued Directions to the Lower Court Which Cannot Be Consistently Followed or Interpreted by the Lower Court Without Clarification by This Court.**

The directions must be explained and amplified by this court to allow the lower court to take intelligent action thereon.

The court has said, as to the Trumble patent, that

it wishes "to adopt a construction of which it is fairly susceptible."

Element (b) of claim 4 reads as follows:

"means within the chamber adapted to cause the oil to flow in a thin body for a distance to enable the gas contained and carried thereby to be given off while the oil is subjected to pressure."

This claim was and is conceded to be valid by the defendant-appellant, and, by implication, by this court.

The court says, page 3 of decision, that this claim (with the others) must be interpreted to mean:

"a structure where the whole *body* of the crude oil is spread *equally* in a *thin film* upon the conical spreader plates and upon the entire chamber wall intermediate between them and the pool level." (The italics are the court's.)

Note that the claim is entirely silent on the following points:

(a) It does not say that the *whole* body of oil is effected.

(b) It does not say that it is *spread equally*.

(c) It does not say anything about a *thin film*.

(d) It is not limited in language to *conical spreader plates*.

(e) It says nothing about spreading the oil on the *chamber wall*.

The court directs the District Court "to enter a decree interpreting the Trumble patent in harmony with the views herein expressed."

How can the District Court logically enter a decree holding the patent *valid* and also holding that the

plain words of element (b), claim 4, mean all that this court says it does?

How can the District Court ignore the plain wording of this claim and read into it *five* limitations not found therein?

It seems to us that the court must reconsider and rewrite its decision in such form that it can be acted upon. Certainly no District Court can enter a decree "in harmony" with the present decision.

It should be noted that our position on this point is concurred in by defendant-appellant who shows in his petition for rehearing that the decision must be amended to permit a consistent decree by the District Court.

Respectfully submitted,

FRANCIS M. TOWNSEND,

MILON J. TRUMBLE,

ALFRED J. GUTZLER,

*Appellees-Petitioners.*

By FREDERICK S. LYON,

LEONARD S. LYON,

FRANK L. A. GRAHAM,

*Attorneys.*

I hereby certify that I have examined the foregoing petition, and in my opinion it is well founded; that the case is one in which the prayer of the petitioner should be granted by this court; and that the petition is filed in good faith and not for the purpose of delay.

FRANK L. A. GRAHAM,

*Of Counsel for Plaintiff-Appellee. FB.*